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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,931	05/30/2006	Riccardo Carlo Giolitti	GIOLITTI ET AL-1 PCT	8734
25889	7590	04/30/2008	EXAMINER	
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			CECIL, TERRY K	
ART UNIT	PAPER NUMBER			
	1797			
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04/30/2008	PAPER			

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/580,931	<b>Applicant(s)</b> GIOLITTI ET AL.
	<b>Examiner</b> Mr. Terry K. Cecil	<b>Art Unit</b> 1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 1-2-2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8 is/are pending in the application.

4a) Of the above claim(s)       is/are withdrawn from consideration.

5) Claim(s)       is/are allowed.

6) Claim(s) 1-8 is/are rejected.

7) Claim(s)       is/are objected to.

8) Claim(s)       are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on       is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No.      .
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SE/08)  
Paper No(s)/Mail Date      

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date      

5) Notice of Informal Patent Application

6) Other:

## **DETAILED ACTION**

### ***Specification***

*Because of applicant's amendments to the abstract and the specification, the objections to the specification of the prior office action with withdrawn.*

### ***Claim Rejections - 35 USC § 112***

*In view of applicant's arguments, the 112, paragraph one, rejections of the prior office action have been withdrawn.*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because of the following reasons:

- In each of claims 1 and 8, the term “the fuel delivery line” lacks antecedent basis.
- Claims 2-7 are rejected since they suffer the same defects as the claims from which they depend.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

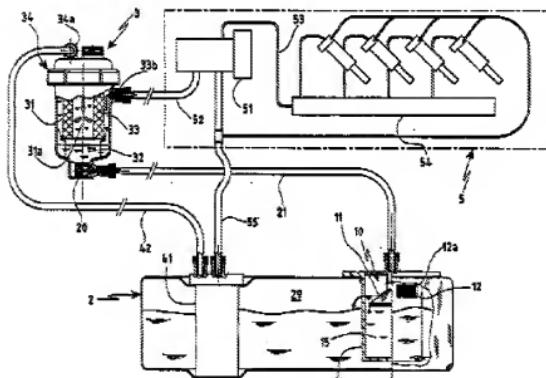
A person shall be entitled to a patent unless –

Art Unit: 1797

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by

International Application (WO 03/067068), hereinafter '068.



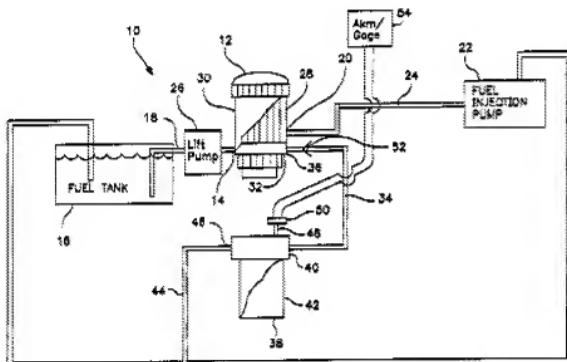
‘068 teaches a fuel filter 3

including a chamber 32 for separated water that is drained into a water collection chamber 15.

The upper area of which is provided with an opening 12 (figure 3) for fuel to return to an area of the fuel delivery line 42. This area 42 is also considered to be *downstream* of the filter 3 because fuel from the filter that flows through line 55 and then into line 42 is *downstream* of the filter 3 (recycle exists). The flow structure from opening 12 that includes the tank 2 and the pump 41 is considered to be the claimed "connecting line" [as in claim 1]. A delivery pump is provided 51

(an element in the fuel delivery line is considered to be between the fuel delivery line and any other element therein)[as in claim 2]. A filter 12 is connected upstream of the opening from the upper area of the water collection chamber [as in claim 7].

5. Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Maxwell (U.S. 6,444,121).



Maxwell also teaches a fuel filter 12 having a water accumulating portion therein that communicates with a water chamber 12 (having a separating/retaining device therein, as in claim 7). A connecting line 44 connects the upper area of the water chamber to an area of the fuel delivery line downstream from the filter 12 (fuel from filter 12 travels via 24 and the fuel injection pump to be an area connected to connection line 44 because of recycle) [as in claim 1].

### **Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 2-4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maxwell in view of Pakula (U.S. 4,637,351). Pakula teaches a venturi 56 for drawing fluids from a water collection chamber acting as a pump and delivering the fluid to a point to a fuel delivery line (air is considered a part of the "fuel" for the engine 10). It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the venturi of Pakula in the invention of Maxwell (e.g. in at the end of connection line 44) in order to provide necessary force to remove the fuel from the water collection chamber (and through the separating element therein). Upon modification all the limitations of claim 8 are taught.

8. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of '068 or Maxwell in view of WO 01/33069 A1, hereinafter '069. '069 teaches a level sensor 21 in a water separation chamber. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the water level sensor of '069 in the water collection chamber 15 of '068 or Maxwell, since '069 teaches the benefit of an alarm 57 for indicating when the water separation chamber is full (and not draining indicating a problem in

the system). As for in figure 1, '069 also teaches a drain (faucet) in the bottom of the water collection chamber 25. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the drain of '069 in the water collection chamber 15 of '068, since such would provide the benefit of emptying the water when full.

***Examiner Notes/Suggestions***

9. Applicant should consider the following changes to the independent claims: claiming that the connection line is configured to deliver separated fuel from the upper area of the water collection chamber to the an area of the fuel line that is downstream of the filter and upstream of the engine to mix with fuel that has directly exited the filter.

***Response to Arguments***

10. Despite applicant's remarks to the contrary, the limitations of amended claim 1 are still taught by '068 because of the recycle configuration. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. (Applicant's amendments changed the scope of the claim such that final is proper). Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date

of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (571) 272-1138 at the Carlisle campus in Alexandria, Virginia for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:30a to 4:30p, on at least four days during the week M-F.
- David R. Sample, the examiner's supervisor can be reached on 571-272-1376, if attempts to reach the examiner are unsuccessful.
- The Fax number for this art unit for official faxes is (571) 273-8300.
- Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mr. Terry K. Cecil/  
Primary Examiner, Art Unit 1797

TKC  
May 2, 2008